

REMARKS

Applicant acknowledges with thanks for the courtesy extended by the Examiner to applicant's representative during the telephone interview that was kindly granted.

During that interview the reference patent to Seufert (5,372,378) was discussed, and in referring to the last Office Action, the Examiner considers that applicant's claims read on this reference patent.

Applicant notes, however, that contrary to the Examiner's position during the interview, the reference patent to Seufert does not disclose an arrangement in which there is continuously varying damping. The entire patent to Seufert is devoted to the description that with the aid of on and off valves 38a and 38b three different damping stages may be attained, such as soft, medium, and hard. This is clearly described in the patent in column 5, lines 68 to column 6, line 10. There is no mentioning in this reference patent of a continuously varying damping force between these stages or at any state of the Seufert damping arrangement.

The Examiner had commented that Figure 3a represents a continuously varying damping feature in the reference patent to Seufert. According to the Examiner, the representations in Figures 3b, 3c and 3d show different stepped operations which are not limited to three different damping stages. These assertions of the Examiner are, however, not correct.

Thus, Figure 3a does not at all show a damping function. Instead, Figure 3a shows the function of a control parameter with respect to time and on which the control of the shock absorber is to follow. This is clearly described in the Seufert reference patent in column 10, line 13 to line 23. As noted in this part of the reference patent, "represented in Figure 3a for the sake of example is a time progression of the operational state quantity BZG, whereby the threshold values SCH-wm for a

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change between the soft and the medium damping characteristics, and SCH-mh for a change between the medium and the hard damping characteristics are entered as dotted lines parallel with the time axis t."

In the specification of the reference patent to Seufert, in column 3, line 65 to column 4, line 5, it is clearly described that the parameter BZG is an operational state quantity which has nothing to do with the damping force. The operational state quantity, as described in the specification at this location, is entirely unrelated to the damping force. In accordance with the specification at this location, the operational state parameter BZG is measured, for example, by steering angle sensors, or vehicle speed sensors, or acceleration sensors which measure the acceleration of the vehicle.

Accordingly, the specification of the reference patent to Seufert is very clear that Figure 3a does not represent a continuous damping function, as asserted by the Examiner. Thus, the Examiner is in error in assuming that the operational state parameter represented in Figure 3a is related to the damping force. Figure 3a does not at all represent a continuous damping function.

Figure 3b of the reference patent to Seufert shows a control function of the shock absorber between the damping steps of soft, medium, and hard, and how it is possible to switch between these three states. The graphical representation in Figure 3b, is a stepped function, and is not a continuous damping function as provided by applicant. This is clearly described in the reference patent to Seufert in column 10, lines 23 to 29. At this location in the specification, it is noted that "shown in Figure 3b is the time progression of the damping characteristic DDW determined from this course of the operational state quantity BZG wherein the time axis t represents a soft damping requirement, and the medium and hard

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damping requirements are represented by dotted lines parallel with the time axis t ."

Figure 3b, furthermore, shows clearly that along the Y axis there are three different damping levels, namely hard, medium, and soft. Therefore, in accordance with the reference patent to Seufert, the damping arrangement can be switched only between these three damping steps or levels. As a result, this reference patent cannot be considered to disclose a continuous damping function.

Similarly to Figure 3a, the graphical representation in Figure 3c does not at all correspond to a damping function. In Figure 3c there is shown, instead, the value T of the timing element 40, as a function of time. Figure 3c, consequently, has also nothing to do with a continuous damping function as provided by applicant.

Figure 3d, finally, shows the different switching states which correspond to the open and closed states of the valve 68a and 58b. This is clearly described in the reference patent to Seufert in column 10, lines 32 to 38. As described at this location of the reference patent, "finally, the switching states of the shut-off valve 68a for soft damping characteristic and 68b for medium damping characteristic have been represented in Figure 3d, and in the diagram, respectively, the open valve state corresponds to a dotted line parallel to the time axis t , and the closed valve state corresponds to the time axis t itself."

In view of the preceding descriptions in the specification of the patent to Seufert, there can be no other understanding except that the controllable damping arrangement in this reference patent is switchable only between three different damping levels and there is no description or anticipation in this reference patent, whatsoever, of a continuous variable damping in the sense of applicant's invention.

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During the interview held with the Examiner, the Examiner considered the throttling valve 60 in the reference patent to Seufert, to correspond or be equivalent to applicant's element 7. This implies that the Examiner considers the element 60 in the reference patent to Seufert, to be a "fixed by-pass valve with non-varying constricted flow cross-section." However, this assumption of the Examiner is incorrect. Thus, in column 5, lines 53 to 59 of the reference patent to Seufert, there is described "The two working chambers 56 and 58 are on the one hand in connection via at least one throttling path 60, possibly, however, also via two throttling paths allowing passage selectively pending on the direction of movement of the piston 54. A throttling path may be formed for example by one valve impinged by a spring."

Since the element 60 provides a throttling effect, this element 60 can be formed as a valve which is spring loaded. Accordingly, here is a classical spring loaded valve which first becomes opened when the pressure is sufficiently high so as to counteract the spring by compressing the spring against its spring force. There is no mentioning anywhere in this reference patent to Seufert, that the element 60 is a by-pass bore with a constant non-variable flow cross-section. In view thereof, the valve 60 cannot be considered to correspond to applicant's element 7.

During the interview held with the Examiner, the Examiner asserted that the elements 5 and 6 of applicant's arrangement correspond to the elements 68a and 68b of the reference patent to Seufert. This is entirely incorrect. In accordance with the reference patent to Seufert, the elements 68a and 68b correspond to electromagnetically actuated on-off valves, as described in the specification of this reference in column 5, lines 63 to 64. It is also clear from this reference patent to Seufert, that these elements 68a and 68b are switchable valves having the states "open" and "closed." These states are necessarily

required to make it possible to switch among the three different damping steps of hard, medium and soft.

Column 5, lines 64 to 68 of the reference patent to Seufert, are related to Figure 1 with the description that the elements 66a and 66b are throttle bores with different flow cross-sections. It is also described there that the throttle bore 66a has a larger flow cross-section than the throttle bore 66b. As a result, the throttle bore 66a has a softer damping characteristics than the throttle bore 66b. Also, according to the reference patent to Seufert, the elements 66a and 66b are not continuously variable damping valves in the sense of applicant's invention.

Applicant is submitting copies of Figures 1 and 3 of the reference patent to Seufert with comments thereon to summarize the essential differences between the reference patent to Seufert and applicant's invention.

In arguing against the claims in the application, the Examiner has erroneously taken elements appearing in the reference patents and compared them to elements present in applicant's arrangement without considering differences in the interrelationships of these elements. The Examiner has argued, for example, that if valves appear in the references and valves also appear in applicant's invention, then they must be comparable. However, it is the interrelationships of the valves that carry out the objects and functions of applicant's invention, and these objects are not available from the combination disclosed in the references.

With respect to the reference patent to Preukschat (4,986,393) this reference discloses first and second damping elements which have different damping characteristics in a switching unit which enables switching between these two separate first and second damping elements.

There is no disclosure or anticipation, whatsoever, in this reference patent to Preukschat of any type of continuous damping

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as provided by applicant. In view of the switching unit between the two damping characteristics, it may be seen that there is no continuity within each characteristic or between them. Thus, this reference patent to Preukschat is confined to two damping characteristics, and each characteristic is a specific one that is not related to the other characteristic.

Even when Preukschat is combined with the reference patent to Seufert, the continuous variable damping provided by applicant cannot be attained.

It is a mistake to assume that if elements present in the prior art reference are also present in applicant's arrangement, then they must necessarily function the same and have the same interrelationships. Applicant's objects can simply not be arrived at through either or combination of the references applied by the Examiner.

It is also a mistake to assume that if a smooth curve is graphically shown in a reference, then such a curve must necessarily correspond to what is present in applicant's invention.

Thus, the graphical representation in Figure 3a in the reference patent to Seufert has nothing to do with damping characteristics. Almost every function in nature can be graphically represented by a continuous or smooth curve, and they are all materially different from each other. The entire Figure 3 of Seufert, has therefore no bearing on applicant's invention.

Applicant provides for a new and marked improvement over the prior art.

Since the claims in the application define clearly the differences between applicant's invention and the prior art, it is believed that the claims should be found allowable.

The Examiner's attention is respectively directed to the court decision in the case of *In re Bisley* (94 U.S.P.Q. 80, 86) in which the Court decided that patentability is gauged not only

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by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

Furthermore, in the case of *ex parte* Chicago Rawhide Manufacturing Company (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In *The Standard Oil Company vs. American Cyanamid Company* (227 U.S.P.Q. 293), the court ruled that the issue of obviousness is determined entirely with reference to a hypothetical person having ordinary skill in the art. It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary

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skill. Inventor's, as a class, according to the concepts underlying the constitution and the statutes that have created the patent system, possess something that sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under 35 U.S.C. 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive systematic research or by extraordinary insight; it makes no difference which.

In the case of *Uniroyal Inc. versus Rudkin-Wiley Corporation* (5 U.S.P.Q.2d 1434), the Court decided that when prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness of making the combination.

The preceding decision is reinforced by the court decision in the case of *In re Dow Chemical Company* (5 U.S.P.Q.2d 1529), in which it was ruled that most technological advance is the fruit of methodical persistent investigation, as is recognized in 35 U.S.C. §103. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

In the case of *United Merchants and Manufacturers Incorporated versus Ladd* (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage

of hindsight, one might off-handedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the references discloses or suggests the concept which is the crux of the invention.

The Patent Office in the case of Ex parte Fleischmann (157 U.S.P.Q. 155), ruled that that while it might be possible to select features from secondary references and mechanically combine them with primary reference to arrive at applicant's claim combination, there is no basis for making such combination disclosed or suggested in references; only applicant's specification suggests any reasons for combining references; under 35 U.S.C. 103, that does not constitute a bar.

In the case of Panduit Corporation v. Burndy Corporation (180 U.S.P.Q. 498), the District Court ruled that inquiry into patentability must be directed towards subject matter as a whole and not to elements of combination and their individual novelty; combination which results in a more facile, economical, or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that elements are individually old.

Finally, in the case of Menge and Drissen (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the preceding analyses of the prior art references in comparison with applicant's invention, it is

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respectfully requested that the claims in the application be
allowed and the case be passed to issue.

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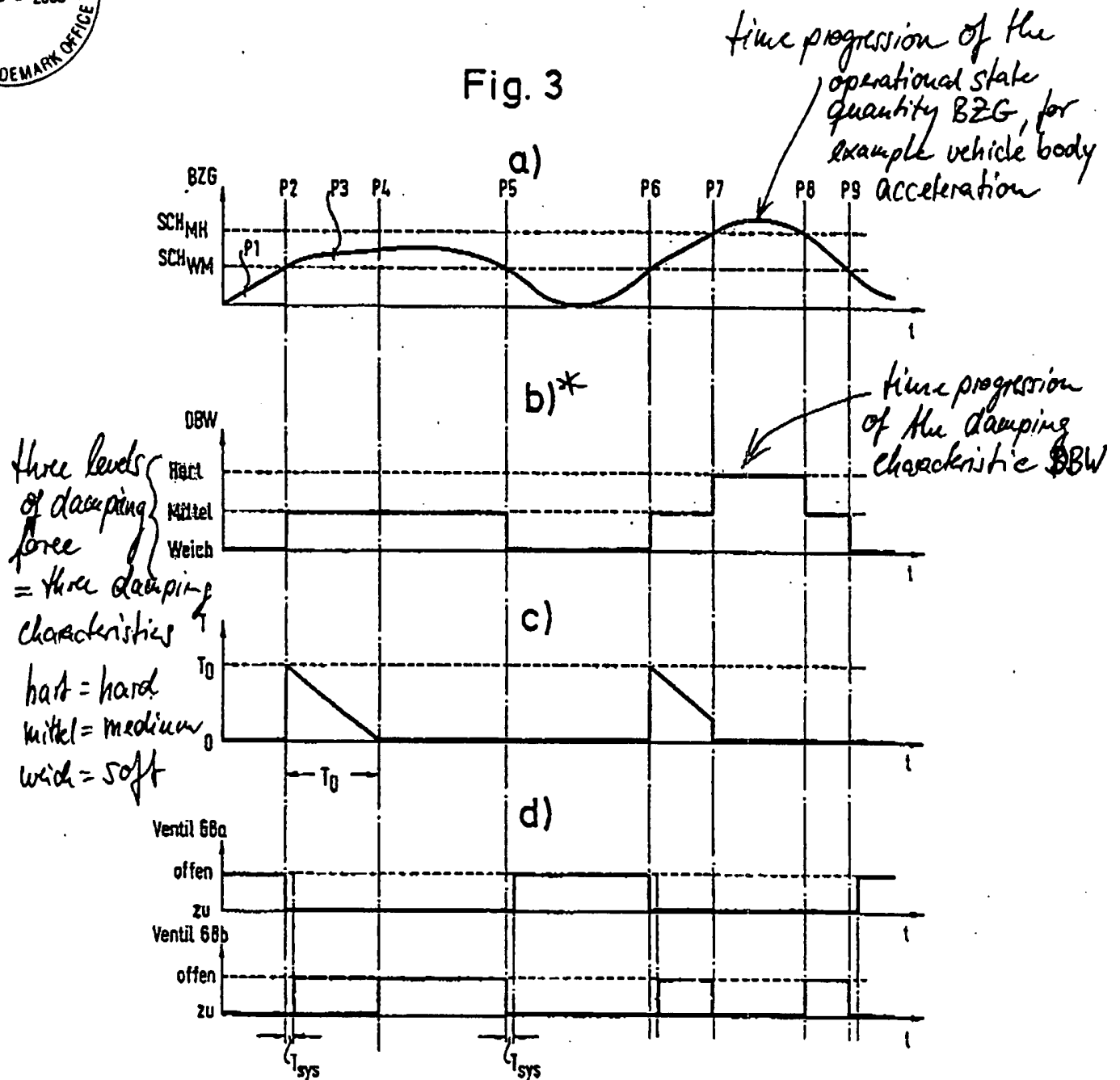
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Reference Sketch for S/N 10/008,895



Fig. 3



* Fig. 3b clearly shows, that in Saferst the damping force is varied only between 3 different discrete damping characteristics (hard, medium and soft). There is no continuous varying of the damping force in Saferst.